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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,544	10/17/2006	David Murray Mcrose	010200-122	7115

21836 7590 06/16/2009
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EXAMINER

PERREAULT, ANDREW D

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

06/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,544

Applicant(s)

MELROSE, DAVID MURRAY

Examiner

ANDREW PERREAULT

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/ISD)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

It is noted that the claims as presented are directed to a product and method of using the product. As currently presented, the method is the mere use of the product and its examination in conjunction with the product does not represent a serious burden at this time; therefore, no restriction is required. However, if subsequent amendments to the claims result in diverging subject matter and searches between the claimed inventions, the examiner reserves the right to restrict at that time.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 21 recite "said seal being one of a flexible material housing an expandable side wall, a flexible material housing an expandable side wall which has a concertina construction." However, it is not understood what applicant means by this limitation .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (6,688,081) in view of Itzel (7,793,475).

Re claim 1, as best understood, Boyd discloses a container (26; figs 2, 4-6) having an upper portion (12) with an opening (16) into said container and a base (bottom portion of 56), said upper portion having a neck finish which includes an expandable and moveable seal (52; fig 5) wherein the seal is configured to be expandable and moveable relative to the container when sealed thereto and when a heated liquid is in the container, said seal moving downwardly towards the base (col. 7, line 29-61) and within the neck finish to compensate for vacuum forces during cooling of the liquid following sealing of the container (col. 1, line 55-62; see col. 6, line 4-16 for cooling); said seal being one of a flexible material housing an expandable side wall (col. 7, line 29-61) which has a construction providing for the expansion and a flexible balloon structure which is able to expand within the neck finish in compensating for vacuum pressure as the liquid cools (col. 7, line 29-61); but does not specifically disclose wherein the construction is concertina.

Itzel discloses a similar device (fig 1-7) comprising a concertina construction within a side wall (figs 2a, 4a, 5b). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the Boyd reference, such that the construction is concertina, as suggested and taught by Itzel, for the purpose of providing a construction suitable to attach additional parts to the device (such as a threaded device for providing mixture components) (figs 2a, 4a, 5b; abstract).

Re claim 2, Boyd discloses wherein a surface (surface of 56; fig 5) of said seal extends transversely across the neck finish and moves further into the neck finish as the seal expands (col. 7, line 29-61).

Re claim 3, Boyd discloses wherein said seal is of said flexible material having an expandable side wall ("headspace-displacing member 56", col. 7, line 27-31 and "compliant gasket material", col. 7, line 53-55; fig 5).

Re claim 4, Itzel discloses said side wall has said concertina construction (portion engaging with the threads 14 in fig 5) providing for its expansion; the obvious modification of Boyd is discussed above.

Re claim 5, Boyd discloses in which the seal includes a rim portion (portion that engages 14 in fig 5) which can engage with a rim (14) of the neck finish.

Re claim 6, Boyd discloses in which said includes a side wall ("headspace-displacing member 56", col. 7, line 27-31 and "compliant gasket material", col. 7, line 53-55; fig 5) which can be physically moved relative to the neck finish and towards the liquid in the container. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 7, Boyd in view of Itzel discloses in which the side wall includes a screw thread (Boyd portion that engages 14 in fig 5; Itzel figs 2a, 4a, 5b) engageable with another screw thread (14) provided for said neck finish or a cap thereof.

Re claim 8, Boyd in view of Itzel discloses in which the side wall provides a push-

fit (col. 7, line 27-31; Itzel figs 2a, 4a, 5b) with at least of the neck finish thereof and a cap thereof; the obvious modification of Boyd is discussed above.

Re claim 9, Boyd discloses wherein said seal provides a primary seal (56) for the container, a secondary seal (top portion of 54 as seen in fig 5) being provided for said neck finish over said opening into said container to define a secondary headspace (57 "hollow space"; fig 5) between the primary and secondary seals.

Re claim 10, Boyd discloses in which a commodity (58 "agent", fig 5) is positioned within said secondary headspace.

Re claim 11, Boyd does not disclose in which said commodity is one of a tablet and a pill intended for mixing with the liquid before use because the structure as much as claimed could so function. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tablet or pill commodity. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference.

Re claim 12, Boyd discloses in which said secondary seal includes one of an aperture and a port (50 "clearance", fig 5; col. 7, line 38-55) to provide access into said secondary headspace (primary seal 56 can be a "relatively thin membrane" that allows for permeation col. 7, line 4-14). Furthermore, it has been held that a recitation with

respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 13, Boyd discloses in which said one of said aperture and said port allows ingress of outside air into said secondary headspace (col. 7, line 38-55; col. 7, line 4-14) closes off following sufficient cooling of the liquid.

Re claim 14, Boyd discloses in which one of said aperture and port enables the entry into the secondary headspace of a commodity (col. 7, line 38-55; col. 7, line 4-14; col. 7, line 56-61). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 15, Boyd discloses in which the commodity is an oxygen-scavenging agent (col. 7, line 56-61). Furthermore, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference.

Re claim 16, Boyd discloses in which the seal is of a flexible balloon structure ("headspace-displacing member 56", col. 7, line 27-31 and "compliant gasket material",

col. 7, line 53-55; fig 5) which expands within the neck finish in compensating for vacuum pressure as the liquid cools (col. 1, line 55-62; see col. 6, line 4-16 for cooling).

Re claim 17, Boyd discloses wherein said base inverts to provide a compression of the seal to move it within the neck finish towards the said opening and to pressurize a secondary headspace above said seal. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 18, Boyd discloses in which said seal is in the form of a cap (fig 5) which is positionable about said opening, said cap being downwardly moveable to compress a headspace beneath the seal (col. 7, line 27-35).

Re claim 19, Boyd discloses in which a mechanical force provides for said downward movement (col. 7, line 27-35).

Re claim 20, Boyd discloses in which the cap is lockable in its downward position (col. 7, line 27-35).

Re claim 21, as best understood, Boyd discloses a method of filling a container (fig 1; col. 5, line 40- col. 6, line 22) having a base (bottom portion of 56) and neck finish (fig 1) with a fluid which method includes introducing the fluid through an open end of the container so that it fills the container (fig 1; col. 5, line 40- col. 6, line 22), heating the fluid at least of one before and after its introduction into the container (fig 1; col. 5, line 40- col. 6, line 22), providing an expandable and moveable seal (52; fig 5) for the open end to cover and contain the fluid, said seal responding to one the expansion and

contraction of the fluid so as to compensate for pressure in a headspace of the container under the seal following sealing of the container (fig 1; col. 5, line 40- col. 6, line 22); by moving downwardly towards the base and within the neck finish, the said seal being one of a flexible material housing an expandable side wall which has a construction providing for the expansion (fig 1; col. 5, line 40- col. 6, line 22), and a flexible balloon structure which is able to expand within the neck finish in compensating for vacuum pressure as the liquid cools (col. 1, line 55-62; see col. 6, line 4-16 for cooling; fig 1; col. 5, line 40- col. 6, line 22); but does not specifically disclose wherein the construction is concertina.

Itzel discloses a similar device (fig 1-7) comprising a concertina construction within a side wall (figs 2a, 4a, 5b). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the Boyd reference, such that the construction is concertina, as suggested and taught by Itzel, for the purpose of providing a construction suitable to attach additional parts to the device (such as a threaded device for providing mixture components) (figs 2a, 4a, 5b; abstract).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW PERREAULT whose telephone number is (571)270-5427. The examiner can normally be reached on Monday - Friday, 8:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (571)272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P./
Examiner, Art Unit 3728

/Ehud Gartenberg/
Supervisory Patent Examiner, Art Unit 3728